Application Number 10/772,537
Art Unit 1639

REMARKS

This response is filed to place the above-referenced case in condition for immediate allowance. As to the claims, claims 1 through 10 and 12 through were previously cancelled. Applicant further cancels claim 11 and claims 16 through 19. Applicant plans to file a divisional application based on the decapeptides identified in claim 11. Applicant further amends claim 15 to correct a grammatical error. No new matter has been added. Reexamination and reconsideration of the application, as amended, is requested.

Because the Applicant has cancelled all claims except claim 15, the Examiner's sequence rule compliance objection to claim 16, the 35 U.S.C. §112 rejection of claim 11, the 35 U.S.C. §112 rejection of claims 16 and 19, and the 35 U.S.C. §§ 102(a) and 102(b) rejections of claims 16 and 19 are now moot.

35 U.S.C. 102 (a) and 102 (b) Rejection of Claim 15 Over Brown et al.

The Examiner has rejected claim 15 under 35 U.S.C. §§ 102(a) and 102(b) as being anticipated by Brown et al., Eur. J. Biochem. Vol. 205, pp. 321-331 (1991) alone, and further in view of the specification as evidence of inherent properties. The Examiner has provided the following reasons for the rejection:

> Brown et al. discloses a "fetuin polypeptide" (e.g. pig fetuin) comprising His Ser Phe Ser Gly Val Ala Ser Val Glu (e.g. see fig. 5, page 327, line 9 from bottom: amino acid number 300-309). Intended use limitations (e.g. "for the treatment of colon and prostate cancer") are not afforded patentable weight in compound/composition claims; and/or the reference peptide which is a decapeptide clearly within the scope of the presently claimed invention MUST inherently "cause apoptosis in colon and prostate cancer cells" (e.g. see present specification for evidence of inherency.) *See* 07/11/05 OA, p. 16.

The Applicant respectfully traverses the Examiner's rejection. For prior art to anticipate under 35 U.S.C. 102 because it is "known," the knowledge must be publicly

accessible. Woodland Trust v. Flowertree Nursery, Inc., 148 F.3d 1368, 1370, 47 U.S.P.Q.2D (BNA) 1363, 1365 (Fed. Cir. 1998). In addition, the disclosure must be sufficient to enable one with ordinary skill in the art to practice the invention. In re Borst, 345 F.2d 851, 855, 145 U.S.P.Q. 554, 557 (CCPA 1965). In order to enable, the prior art reference **must teach one of ordinary skill in the art to make or carry out the claimed invention without undue experimentation**. Nat'l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc., 166 F.3d 1190, 1195-96, 49 U.S.P.Q.2D (BNA) 1671, 1675 (Fed. Cir. 1999) (emphasis added). The Applicant submits that the Brown reference would not enable one of ordinary skill in the art to make or carry out the Applicant's claimed invention without undue experimentation.

Brown is a publication generally discussing the common structural features of the mammalian fetuin family. Specifically, Brown discloses and discusses the similarities between the amino acid sequences of fetuin proteins in different organisms (sheep, pig, human, cow and rat). According to Brown, the cDNA insert encoding the pig fetuin comprises 1470 nucleotides, including 46 nucleotides encoding a signal peptide of 15 residues and 1041 nucleotides encoding the 347 amino acids of the mature plasma protein

Brown does in Figure 5 show the entire 347 amino acid pig fetuin sequence, and identifies a 38 amino acid connecting peptide within the pig fetuin. This connecting peptide apparently includes the ten amino acids which form the decapeptide isolated, tested and claimed by the Applicant in the present application for its apoptotic activity in cancer cell lines. However, Brown in no way suggests or teaches that the 38 amino acid peptide contains a distinct 10 amino acid peptide identified by the Applicant, let alone suggest that this decapeptide may increase apoptotic activity in prostate and colon cancer

cells. In fact, Brown does not at all discuss the relation between the pig fetuin amino acid sequence and apoptosis in cancer cell lines. It is clear that from reading the Brown disclosure, one of ordinary skill in the art would not be able to predict that a decapeptide isolated from pig fetuin would have the ability to increase apoptosis in prostate and colon cancer cell lines. As such, Brown does not anticipate the Applicant's claim.

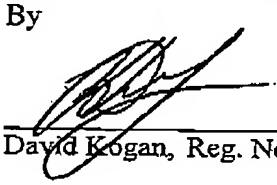
For the above reasons, the Applicant submits that Brown et al is not a proper 35 U.S.C. §102 reference against Applicant's claim 15. Claim 15 claims a specific ten amino acid sequence of pig fetuin and its function of causing apoptosis in prostate cancer and colon cancer cell lines. Brown in no way suggests the relationship between pig fetuin and apoptosis nor does Brown identify which ten amino acids of the 347 in pig fetuin would be responsible for apoptotic activity in cancer cells. As such, Brown is not an enabling prior art reference with respect to the Applicant's pending claim. Thus, the Examiner's rejection of claim 15 over Brown et al. is requested to be withdrawn.

Conclusion

In view of the foregoing, the Applicant submits that this case is in condition for immediate allowance, and such action is respectfully requested. If the Examiner feels that a telephone conference or an Examiner's amendment may expedite this case toward allowance, the Examiner is requested to contact the Applicant at (310) 777-8399.

Respectfully Submitted,

TROJAN LAW OFFICES
By



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